THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

The opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.

Paper No. 28

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

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Ex parte PETER M. POZNIAK, BENJAMIN R. ROBERTS, and RONALD W. MICHELSON, CURTIS L. LINDSKOG and A. LAIRD LOBBAN

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Appeal No. 95-0730
Application 08/068,575[1]

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ON BRIEF

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Before CALVERT, Administrative Patent Judge and McCANDLISH, Senior Administrative Patent Judge and COHEN, Administrative Patent Judge.

McCANDLISH, Senior Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on an appeal from the examiner's final rejection of claims 1 through 7, 9 through 12, 16, 17, 19 through

[1]Application for patent filed May 26, 1993. According to appellant this application is a continuation of Application no. 07/837,234 filed February 14, 1992, now abandoned.

24, 47 through 49, 51 and 53.[2] No other claims are pending in the application.

Appellants' invention relates to a hazardous material treatment plant for processing hazardous material from a site. According to claims 1 and 19, which are the only independent claims on appeal, the treatment plant comprises a transportable enclosure (150), a hazardous treatment facility (250) located in the enclosure, a connection means (e.g., 252a) coupled to the treatment facility and a connection port (100) located at the site and coupled to the connection means. The connection port is recited to comprise a means (e.g., 20, 21) for extracting the hazardous material from ground soil and/or ground water at the site for processing in the treatment facility, and the extracting means, in turn, is recited to comprise one or more transport lines extending into the ground at the site. Both of the independent claims on appeal recite that the treatment facility may be one of a plurality of different types of treatment facilities and that one of the types of treatment facilities is "optimized for treating a different concentration range of said hazardous material than another of said types of hazardous

[2] An amendment (paper No. 19) filed after the final rejection and involving claims 1, 2, 11, 16, 19, 22, 47 through 49, 51 and 53 has been entered by the examiner.

material treatment facilities . . .”

A copy of the appealed claims is appended to appellants’ brief.

The following references are relied upon by the examiner as evidence of obviousness in support of his rejections under 35 U.S.C. § 103:

Valiga et al. (Valiga)	4,352,601	Oct. 05, 1982
Muller et al. (Muller)	4,383,920	May 17, 1983
Katz	4,838,733	Jun. 13, 1989
Heintzelman et al. (Heintzelman)	5,030,033	Jul. 09, 1991
Silinski et al. (Silinski)	5,102,503	Apr. 07, 1992
		(Filed Aug. 04, 1989)

Appealed claims 1 through 3, 9 through 12, 16, 17, 19 through 24, 47, 49, 51 and 53 stand rejected under 35 U.S.C. § 103 as being unpatentable over Silinski in view of Muller and Katz, and appealed claims 4 through 7 and 48 stand rejected under 35 U.S.C. § 103 as being unpatentable over Silinski in view of Muller, Katz, Valiga and Heintzelman. Appealed claims 1 through 7, 9 through 12, 16, 17, 19 through 24, 47 through 49, 51 and 53 additionally stand rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which appellants regard as their invention.

With regard to the rejection of the appealed claims under the second paragraph of § 112, the examiner’s difficulty with the

claim language centers on the word "optimized" in the independent claims. According to the examiner, "it is unclear structurally how the hazardous treatment means [sic, facility?] is optimized for treating a different concentration range" (answer, page 4).

With regard to the § 103 rejection of independent claims 1 and 19, the examiner has taken the following position:

> Muller et al recognize the use of specifically designed liquid conduits and valves (ie., a manifold type system) which permit the treatment tanks to be operated in series, in parallel, or in series/parallel (See col. 1, lines 54+). Also, the use of a connection port comprising one or more transport/extraction lines located at a site to transport/extract fluids was known in the art, at the time the invention was made, as evidenced by Katz (see Fig. 1).
>
> It would have been obvious to one of ordinary skill in the art to utilize the connection means or manifold system as taught by Muller et al in the Silinski et al hazardous material processing apparatus in order to enable coupling of various types of hazardous material treatment tanks in a series mode, parallel mode, or in a series/parallel mode. Also, it would have been obvious to one of ordinary skill in the art to couple the connection port as taught by Katz to the Silinski et al hazardous material processing apparatus in order to cover and allow for the treatment of a large surface area.

Reference is made to the examiner's answer for further details of his rejections.

We have carefully considered the issues raised in this appeal together with the examiner's remarks and appellants' arguments. As a result, we conclude that the rejections of the

appealed claims cannot be sustained.

Considering first the rejection under the second paragraph of § 112, it is established patent law that the claims must define the metes and bounds of the invention with a reasonable degree of precision. In re Venezia, 530 F.2d 956, 958, 189 USPQ 149, 151 (CCPA 1976). In the final analysis, the question as to whether or not language in a claim complies with § 112 ¶ 2 requires a determination of whether those skilled in the art would understand what is claimed when the claim is read in light of the specification. Seattle Box Co. v. Industrial Crating & Packing, Inc., 731 F.2d 818, 826, 221 USPQ 568, 574 (Fed. Cir. 1984).

When the recitation that at least one of the treatment facilities is “optimized” for treating a different concentration range is read in light of appellants’ specification in the present case, we are satisfied that one of ordinary skill in the art would have understood that claim language to mean that at least one of the treatment facilities is more efficient for processing a particular concentration of a hazardous material than one of the other types of treatment facilities. Furthermore, it is not necessary for the claims to recite the particular structure which optimizes the treatment for a given concentration

range of a hazardous material as the examiner seems to suggest in his remarks quoted supra. Instead, there is nothing intrinsically wrong with the use of functional language to define what the

treatment facility does. See In re Swinehart, 439 F.2d 210, 212, 169 USPQ 226, 228 (CCPA 1971). Accordingly, we must reverse the rejection of the appealed claims under the second paragraph of § 112.

With regard to the § 103 rejections of the appealed claims, the Silinski patent does disclose a transportable facility for treating what may be regarded as a hazardous material. Silinski's treatment facility, however, is specifically designed to recover cleaning solvents from the waste of a painting process where the waste is stored in drums, tanks or other containers at the processing site. As such, Silinski's treatment facility is not equipped or even intended to extract and process a hazardous material which is present in the ground.

The Muller patent also does not disclose a treatment plant which is equipped to extract and process hazardous material present in the ground. Instead, this reference merely discloses a transportable plant for purifying a liquid such as water.

Unlike the treatment facilities disclosed in the Silinski and Muller patents, the system disclosed in the Katz patent is not a treatment facility for processing any type of material, let alone a hazardous material. Instead, this reference discloses a system having a vacuum pump connected to tubular conduits inserted into a landfill to evacuate gas from the landfill to make the landfill more compact. Thus, contrary to the examiner's position, we find no teaching in this patent or any of the other cited references of connecting Katz' ground-penetrating gas extraction tubes to Silinski's recovery facility.

In applying the references as he did, the examiner seems to have lost sight of the fact that, as framed, his rejection requires the modification of a particular treatment facility, namely Silinski's solvent recovery facility, not just any treatment facility. Since the solvents to be recovered with Silinski's facility are not located in the ground, there is no reason that would have motivated one of ordinary skill in the art to connect Silinski's facility to transport lines or tubes extending into the ground. Furthermore, the Heintzelman and Valiga patents do not rectify the deficiencies of the references

applied in the rejection of claims 1 and 19.

Accordingly, we cannot agree that the combined teachings of the applied references suggest the subject matter recited in independent claims 1 and 19 and, hence, the subject matter embraced by the appealed dependent claims, to warrant a conclusion of obviousness under the test set forth in In re Keller, 642 F.2d 413, 425, 208 USPQ 871, 881 (CCPA 1981). We therefore must reverse the § 103 rejections of claims 1 through 7, 9 through 12, 16, 17, 19 through 24, 47 through 49, 51 and 53.

The examiner's decision rejecting the appealed claims is reversed.

REVERSED

IAN A. CALVERT)
Administrative Patent Judge)
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) BOARD OF PATENT
HARRISON E. McCANDLISH) APPEALS AND
Senior Administrative Patent Judge) INTERFERENCES
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IRWIN CHARLES COHEN)
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